

REMARKS/ARGUMENTS

The Office Action mailed August 17, 2011, has been received and the Examiner's comments carefully reviewed. Claims 1-5 and 7-20 are rejected. Claims 1, 10 and 16 have been amended. The Applicants present the following for consideration.

Claim Rejections Under 35 USC § 112

Claims 1, 10, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. While the Applicants respectfully disagree, Claims 1, 10 and 16 have been amended to address the rejections. The Applicants respectfully request the rejections be withdrawn.

Claim Rejections Under 35 USC § 103

Claims 1, 3, 5, 7, and 9 are rejected under 35 U.S.C. 103(a) as being obvious over Schwartz et al, U.S. Patent Publication NO. 2004/0135816 ["Schwartz"] in view of Kobashikawa et al, U.S. Patent NO. 7,539,699 ["Kobashikawa"], in further view of Huang et al., U.S. Patent No. 5,966,714 ["Huang"]. Claims 10, 11, and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang et al, U.S. Patent No. 5,966,714 ["Huang"], in view of Kobashikawa and Schwartz. Claims 16, 19, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Kobashikawa. Claims 12, 14, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang and Kobashikawa, in further view of Kraenzel et al, U.S. Patent Publication No. 2005/0198144 ["Kraenzel"]. Claims 13 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang and Kobashikawa, in further view of Lake, U.S. Patent No. 7,200,638. Claim 2 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Schwartz, Kobashikawa, and Huang, in further view of Kraenzel. Claim 4 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Schwartz, Kobashikawa, and Huang, in further view of Lake. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz, Kobashikawa, and Huang, in further view of Calder et al, U.S. Patent Publication No. 200110034244 ["Calder"]. In response, the claims have been amended to more clearly define the invention.

Claim 1, as amended, recites in part “wherein upon selection of a provided GAL contact to edit, the provided GAL contact is added to the user’s personal contacts such that the provided GAL contact that was edited becomes one of the user’s personal contacts during a next synchronization and is synchronized as a personal contact rather than a GAL contact.” Among other differences, the cited reference do not teach adding a GAL contact to the personal contacts of a user upon selection of a GAL contact to edit.

In contrast, Schwartz teaches obtaining likely recipients and keeps a list of recipients based on communications to the recipients. Schwartz teaches that a user is prompted before the contact is added to a user’s address book and nowhere does Schwartz teach or suggest that upon selection of a provided GAL contact to edit, the provided GAL contact is added to the user’s personal contacts. The addition of the other cited references fail to cure these deficiencies. For example, the Huang reference teaches generating a personal address book and keeping the personal address book synchronized with a master database. At col. 9, lines 57 - 65, Huang recites that “In step 347, it is determined whether there is an address already in PAB 128 for the message. If there is already an address for the message in the PAB 128, then in step 348, the address ranking is updated based upon the type of address, (“TO”, “CC”, “BCC”, “AUTHOR”, etc.) and the other characteristics of the message (size, urgency, text included, etc.). Otherwise, if the address is not already in PAB 128, then in step 349, it is determined whether or not the address is in MAB 126.” Determining whether an address is already in a PAB processing an address as described by Huang, however, does not teach or suggest that upon selection of a provided GAL contact to edit, the provided GAL contact is added to the user’s personal contacts such that the provided GAL contact that was edited becomes one of the user’s personal contacts during a next synchronization and is synchronized as a personal contact rather than a GAL contact. The Kobashikawa reference only teaches searching for addresses to add to an address book from emails. Since Huang, and the other cited references, fail to teach the recitations of Claim 1, Claim 1 is proposed to be allowable. Claims depending from Claim 1 are proposed to be allowable as they depend on a valid base claim.

As amended, Claim 10 recites in part “displaying the GAL contacts on the display; and upon selection of one of the GAL contacts to edit adding the edited GAL contact as a personal contact to the user’s personal contacts on the device such that the edited GAL contact is one of

the user's personal contacts during a next synchronization." Claim 10 is proposed to be allowable for at least reasons presented above. Claims depending from Claim 10 are proposed to be allowable as they depend on a valid base claim.

As amended, Claim 16 recites in part "wherein upon selection of a GAL contact on the device to edit, the GAL contact is added to the user's personal contacts such that the GAL contact becomes one of the user's personal contacts during a next synchronization and is synchronized as a personal contact rather than a GAL contact." Claim 16 is proposed to be allowable for at least reasons presented above. Claims depending from Claim 16 are proposed to be allowable as they depend on a valid base claim.

Conclusion

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number provided below.

P.O. Box 2903
Minneapolis, MN 55402-0903
206.342.6200



Respectfully submitted,
MERCHANT & GOULD P.C.

/Timothy P. Sullivan/
Timothy P. Sullivan
Reg. No. 47,981
Direct Dial 206.342.6254